

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Richard R. REISMAN

Appl. No.: 09/553,397

Filed: April 20, 2000

For: **Software and Method for
Monitoring a Data Stream and for
Capturing Desired Data within the
Data Stream**

Confirmation No.: 4230

Art Unit: 2182

Examiner: NGUYEN, TANH Q

Atty. Docket: 2222.4310009

Petition to Accept Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits this Petition under 37 CFR §1.181 to require the Examiner in the above-referenced application to enter the Information Disclosure Statement filed August 9, 2007 and to consider the references cited therein.

The Examiner has made improper and incorrect assumptions based on Applicant's statements during prosecution and has drawn improper conclusions therefrom. If proper conclusions are drawn from Applicant's statements and in light of the applicable law, it is clear that the Information Disclosure Statement must be entered and that the documents cited therein must be considered by the Examiner.

Facts

On August 9, 2007, Applicant submitted a Seventh Supplemental Information Disclosure Statement. The IDS contained the following statements:

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicant has listed publication dates on the attached IDS Forms based on information

presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicant reserves the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

On February 22, 2008, the Examiner issued a Final Office Action objecting to the

IDS. The Examiner stated:

1. The information disclosure statement (IDS) filed August 9, 2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicant states that "However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated" - see second paragraph of the front page of the IDS. Such statement suggests that the dates may not be valid, and therefore does not comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any resubmission of any item of information contained in this IDS or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

4. The examiner further notes that numerous references listed on the information disclosure statement (IDS) filed August 9, 2007 were previously considered by the examiner. Applicant needs to submit IDS listing only references not previously considered or not previously cited by the examiner. A submission of IDS that includes references previously considered or cited would increase the burden of examination because the examiner has to find out which of the references not to consider, or inadvertently **consider** the previously considered or cited references **again**.

5. Furthermore, the extraordinary large number of references cited in the information disclosure statement (IDS) filed August 9, 2007 is clouding the issue of patentability of the outstanding claims in the current application. Since applicant states "Listed on accompanying IDS Forms are documents that may be considered material to the examination of this application", applicant essentially suggests that the documents are **not necessarily material** to the examination of the current application - see

first paragraph of the front page. Furthermore, it is not likely that all the references submitted are material to the claims of the present application. **The examiner requests that applicant particularly points out the references germane to the claims within the application.**

Note that, per MPEP 2004 (.13), it is desirable to avoid the submission of long lists of documents if it can be avoided. **Eliminate clearly irrelevant and marginally pertinent cumulative information.** If a long list is submitted, **highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance.** See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

An applicant's duty of disclosure of material and information is not satisfied by presenting a patent examiner with "**a mountain of largely irrelevant [material] from which he is presumed to have been able, with his expertise and with adequate time, to have found the critical [material]. It ignores the real world conditions under which examiners work.**" *Rohm & Haas Co. v. Crystal Chemical Co.*, 722 F.2d 1556, 1573 [220 USPQ 289] (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). (Emphasis in original). Patent applicant has a duty not just to disclose pertinent prior art references but to make a disclosure in such way as not to "bury" it within other disclosures of less relevant prior art; See *Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co. Inc.*, 24 USPQ2d 1801 (N.D. Ind. 1992); *Molins PLC v. Textron Inc.*, 26 USPQ2d 1889, at 1899 (D.Del. 1992); *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc. et al.*, 175 USPQ 260, at 272 (S.D. Fl. 1972).

Office Action, February 22, 2008, pp. 2-4 (emphasis in original).

On June 19, 2008, Applicant responded to the Final Action and specifically to the Examiner's objection to the IDS. Applicant argued in part:

Applicant submits that none of 37 CFR 1.97 or 1.98 or MPEP §609 addresses the Examiner's objected to statement. There is nothing in either rule or in the MPEP section that mentions anything about admitting an actual date of publication where the document submitted contains a publication date. In making his submission, Applicant acknowledges that the several documents are dated. Applicant cannot guarantee that the documents were in fact made publicly available as of their stated publication dates. The Examiner is free to use the publication dates as an effective date of the documents as references. Applicant reserves the

right to challenge any stated publication date should it become necessary or desirable to do so.

Applicant has clearly satisfied the requirements of 37 CFR 1.97 and 1.98 and MPEP §609. Except as noted below, Applicant requests that the Examiner review the documents identified in the IDS on their merits in connection with the claims of this application. If the Examiner continues to object to the Information Disclosure Statement on this basis, it is requested that he point out with particularity which part of either the CFR or MPEP sections has not been met.

The Examiner further states that numerous references listed on the information disclosure statement (IDS) filed August 9, 2007 were previously considered by the examiner. "Applicant needs to submit IDS listing only references not previously considered or not previously cited by the examiner. A submission of IDS that includes references previously considered or cited would increase the burden of examination because the examiner has to find out which of the references not to consider, or inadvertently consider the previously considered or cited references again."

Office Action, pp. 4-5.

Applicant points out that only the following references cited in the IDS of August 9, 2007 had been submitted in previous IDS 's in this application:

US 172
US 174
US 175
US 176
NPL218
NPL219
NPL220
NPL221
NPL222

To the extent the Examiner has previously considered these references, Applicant does not expect the Examiner to again review them.

The majority of the references submitted in the IDS of August 9, 2007 were brought to Applicant's attention by defendants during the course of two litigations, namely

Teleshuttle Technologies, L.L.C. et al v. Microsoft Corporation, U.S.D.C. ND CA CIVIL CASE #: 5:04-cv-02927-JW

Teleshuttle Technologies, L.L.C. et al v. Microsoft Corporation et al, U.S.D.C. ND CA CIVIL CASE #: 5:04-cv-02928-JW.

Others of the listed documents were cited by Examiners in Applicant's related applications.

The documents submitted in the IDS of August 9, 2007 were presented in an abundance of caution. Applicant does not assert that either he or his representatives have reviewed each listed document in detail in connection with the herein claimed invention. Applicant is not aware that any of the listed documents are more material to the claims of this application than are the references that have already been considered by the Examiner.

On June 30, 2008, the Examiner issued an Advisory Action, refusing to enter Applicant's response.

On July 10, 2008, Applicant filed a Request for Continued Examination.

On September 8, 2008, the Examiner issued a Non-Final Action, again objecting to the IDS. The Examiner stated:

Applicant submits that there is nothing in the rules and in the MPEP that mentions anything about admitting an actual date of publication where the document submitted contains a publication date. Applicant further indicates that in making the submission, applicant acknowledges that several documents are dated, and that applicant cannot guarantee that the documents were in fact made publicly available as of their stated publication dates. Since the dates may be incorrect, and since the examiner does not have any means for readily determining whether the dates are correct, the examiner considers all the dates to be incorrect. In conformance with the rules, the examiner cannot acknowledge documents with incorrect information (note that Form 1449 has a provision for crossing out documents that are not in conformance and not considered at the bottom of the form; documents with incorrect information are considered not in conformance and are not acknowledged by the examiner). Furthermore, determining whether the dates on the documents are correct would **substantially increase the burden of examination**.

Applicant also indicates that the examiner is free to use the publication dates as effective dates, but reserves the right to challenge any stated publication date should it become necessary or desirable to do so. In so doing, applicant essentially provides the examiner with a mountain of references without pointing out which of the references have correct dates, and **substantially increase the burden of examination - if and when references with incorrect dates from the IDS are used**.

The examiner suggests that applicant submits a new IDS listing only references with correct dates for consideration. Note that the IDS filed

August 9, 2007 has already been processed and mailed to applicant. A new IDS is required if applicant still wishes to have the references with correct dates considered. Applicant can indicate that the references listed were previously provided when submitting the new IDS.

3. Applicant points out certain references that were submitted prior to the submission of the IDS of August 9, 2007. Applicant needs to submit a new IDS without those references because the IDS of August 9, 2007 has already been processed and mailed to applicant.

4. Applicant indicates that the documents submitted in the IDS of August 9, 2007 were presented in an abundance of caution in connection with two litigations and applicant's related applications, that the documents were not reviewed in detail in connection with the herein claimed invention, and that applicant is not aware that any of the documents are more material to the claims of the current application than the references already considered by the examiner.

It is not clear to the examiner what applicant meant by - applicant being not aware that any of the documents are more material to the claims of the current application than the references already considered by the examiner. It appears that applicant intends for the documents to be not material to the claims of the current application. Accordingly, unless applicant specifically indicates the documents that are material to the claims of the current application in the new IDS - by pointing out the relevancy of the documents that are material to the claims of the current application, the examiner will consider that none of the documents in the new IDS are material to the claims of the current application, that the documents are presented in an abundance of caution, and that the documents are material only to the two litigations and the related applications.

Non-Final Action, September 8, 2008, pp. 2-4 (emphasis in original).

Arguments

In refusing to enter the IDS of August 9, 2007, the Examiner has turned Applicant's statements on their ear. The Examiner has made several incorrect and improper assumptions.

Improper Assumption that dates are incorrect

The Examiner argues that:

Applicant . . . indicates that in making the submission, applicant acknowledges that several documents are dated, and that applicant cannot

guarantee that the documents were in fact made publicly available as of their stated publication dates. Since the dates may be incorrect, and since the examiner does not have any means for readily determining whether the dates are correct, the examiner considers all the dates to be incorrect.

What the Examiner has failed to consider are the following statements made by Applicant: "Applicant acknowledges that *the* several documents are dated." In other words, Applicant did not indicate that several documents were dated. Applicant stated that "the several" documents (*i.e.* all the listed documents) were dated. Applicant also stated that, while Applicant could not guarantee that the documents were in fact made publicly available as of their stated publication dates, "[t]he Examiner *is free to use the publication dates as an effective date of the documents* as references."

Thus Applicant acknowledged that the Examiner could use the publication dates of the references as their effective date. However, Applicant "reserve[ed] the right to challenge any stated publication date should it become necessary or desirable to do so." There is nothing improper about reserving such a right. Neither the CFR nor the MPEP prohibit such a reservation. It is only prudent that an applicant should preserve any argument available to challenge the propriety of a reference if it becomes necessary or desirable to do so.

By acknowledging that the Examiner was free to use the publication date of any of the listed documents as the effective date, Applicant at the very least implied that the Examiner could assume that the dates of publication were the proper dates to use. Instead, the Examiner improperly concluded that because Applicant could not guarantee the public availability of the documents as of their stated publication dates, the dates *may be* incorrect, and the examiner could therefore consider all the dates to be incorrect. There is no logical basis for the Examiner's improper and incorrect conclusion.

Improper Assumption concerning materiality of documents

Applicant stated that the documents submitted in the IDS of August 9, 2007 were brought to his attention in connection with two litigations and/or were cited by Examiners in Applicant's related applications. Applicant further noted that the documents had not been reviewed in detail in connection with the herein claimed invention, but that applicant was not aware that any of the documents are more material to the claims of the current application than the references already considered by the examiner.

The Examiner responded by stating that it was not clear to him what applicant meant by applicant not being aware that any of the documents were more material to the claims of the current application than the references already considered by the examiner. It is hard to state Applicant's position more clearly. To the best of Applicant's knowledge and belief, the documents cited in the IDS are no more material to the claimed invention than the references that have already been considered by the Examiner. In other words, to the best of Applicant's knowledge and belief, the documents cited in the IDS are merely cumulative of the references of record.

The Examiner then incorrectly assumed that "[i]t appears that applicant intends for the documents to be not material to the claims of the current application." This is an assumption without basis in fact or law. Applicant was merely stating that he was not aware that the cited references are or are not material. There is no requirement in fact or law that the Applicant identify the materiality of any document cited in an IDS.

The Court of Appeals for the Federal Circuit has clearly stated that

[The mere submission of an IDS to the USPTO does not constitute the patent applicant's admission that any reference in the IDS is material prior

art. According to Patent Office rules, “[t]he filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to the patentability defined in § 1.56(b).” 37 C.F.R. § 1.97(h) (2000). While valid prior art may be created by the admissions of a party, these admissions are generally characterized by statements made during prosecution describing certain work as “prior art.” See *In re Nomiya*, 509 F.2d 566, 571 n. 5 (CCPA 1975); *In re Fout*, 675 F.2d 297, 300-01 (CCPA 1982).

Abbott Laboratories v. Baxter Pharmaceutical Products, Inc., 334 F.3d 1274, 1279 (Fed. Cir. 2003); *see also* *Riverwood International Corporation v. R.A. Jones & Co., Inc.*, 324 F.3d 1346, 1355 (Fed. Cir. 2003).

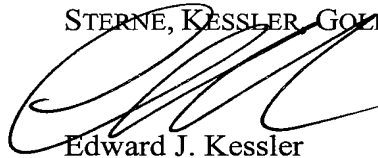
Conclusion

Applicant submitted an Information Disclosure Statement in a good faith effort to comply with his Duty of Disclosure under 37 CFR §1.56. Applicant complied with all of the requirements of 37 CFR §§1.56, 1.97, and 1.98. The Information Disclosure Statement submitted on August 9, 2007 should be entered and the documents listed therein should be considered by the Examiner.

Prompt and favorable consideration of this Petition is respectfully requested.

Respectfully submitted,

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